

## Remarks

The following *Remarks* deal with Examiner's objections and rejections in the order in which they are presented in the Office action of 10/18/05.

### **The objection to the Specification**

Applicants have provided a new copy of the Abstract which is less than 150 words long.

### **The rejection of claims 1-4 under 35 U.S.C. 112, second paragraph**

Applicants have amended the last clause of claim 1 as follows:

providing the comment to a medical information specialist in the intermediary who is neither the first nor the second physician, the medical information specialist providing the continuing medical education credit by recording the continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary.

The added language clearly adds no new matter. Applicants believe that it also overcomes the "gap" between the elements.

### **The rejection of claims 1-4 under 35 U.S.C. 101**

Examiner gives two bases for her rejection:

- "...claims 1-4 do not have a tangible result, as there is no tangibly embodied continuing medical education credit that results from the method steps ..."; and
- "...for a claimed invention to be statutory, it must also produce a concrete result, that is, a result must be assured or repeatable. ... Examiner ... notes that the results of the recited receiving and providing steps are not assured, that is a subjective evaluation done by the medical information specialist might result in different final results ..."

As for the first base of the rejection, claim 1 as amended sets forth that Applicants' method

record[s] the continuing medical education credit for the first physician based at least on the comment in a database accessible from the intermediary.

The use of the verb “record” in the amended claim leaves no doubt that there is a tangible result from the method, namely a change in the database. The tangible result here is similar to the tangible result in the State Street Bank claims as construed by the court. There, the tangible results were the results of computations. The results of the computations were stored in files.

Regarding the second base of the rejection, the claim sets forth “a method for providing continuing medical education credit”, i.e., a method whose last step is completed *after* the medical information specialist has decided that credit is to be provided. The method as claimed has the same results whenever it is performed, namely, a CMEC for the first physician which is based at least on the comment is recorded in a database. The results of the method as claimed are thus not dependent on the results of a subjective evaluation done by the medical information specialist. That being said, Applicants’ attorney is further not aware of any cases that hold that a claim is non statutory because method steps in the claim or interactions between elements of the claim are determined by inputs based on the subjective perceptions of users of a system. See in that regard claims 3 and 4, which Examiner has not rejected under 35 U.S.C. 101.

#### **Traversal of the rejection of claims 1 and 2 under 35 U.S.C. 102**

The problem with Examiner’s rejection is that it ignores the fundamental requirement for a rejection under 35 U.S.C. 102. As set forth at MPEP 2131:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). (MPEP rev 3, Aug. 2005, p. 2100-76)

The Telemedicine reference does not satisfy this requirement.

#### *The failure of the Telemedicine reference to show the limitations of claim 1*

Telemedicine is a 1996 survey of the new possibilities that the improvements in information processing and telecommunications which were taking place in the 1990’s offered the medical profession. Among the possibilities considered in the VVA report are “the transmission of health care information and information on education and

administrative services” (p.1, col. 1, bottom) and the use of “two-way, interactive telecommunications video systems to examine patients from remote locations, to facilitate medical consultations, and to train health care professionals” (p.1, col. 2, bottom). Further discussed are the uses of the technology for rural hospitals and health providers (page 3, col. 1, top) and the University of Washington’s use of telecommunications technology to overcome distance with regard to medical education, delivery of health care, and conferences among providers (page 4, col. 2, middle). There is also a discussion of the difference for licensing purposes between using telecommunications technology to provide care directly to a patient from an out of state location and using the technology for consultations between doctors. (page 14, col. 2, top) Implications for medical practice of live and store-and-forward telecommunications interactions are discussed at page 19, col. 1, beginning in the second paragraph.

The problem with all of this disclosure is that, as might be expected from the nature of Telemedicine, there is no detailed disclosure of particular uses of telecommunications in medicine. As set forth above, however, a rejection of a claim under 35 U.S.C. 102 requires that the reference that is serving as the basis of the rejection disclose *every limitation* of the claim being rejected. Telemedicine provides no such disclosure with regard to the method of Applicants’ claim 1. As set forth in the claim’s preamble, Applicants’ claim 1 is directed to “a method of providing continuing medical education credit”. The reference discloses the use of telecommunications technology for continuing medical education, but discloses *nothing whatever* about using the telecommunications technology to provide continuing medical education credit.

As further set forth in the preamble, the “continuing medical education credit” is provided under very particular circumstances: it is provided “to a first physician who has been engaged in consultation with a second physician via an intermediary”. Finally, the steps are “performed in the intermediary”. Again, the reference discloses that telecommunications technology may be used for consultations between physicians, but *nothing whatever* about such consultations taking place via *any* intermediary, let alone one that is connected by a telecommunications system to both the first and second physicians.

The environment set up by the preamble is referred to repeatedly in the steps of the method, and thus must be taken into account in interpreting the claim. Thus, the “comment” of the first method step is “made with regard to the consultation” and “received via the telecommunications system from the second physician”. Further, in the second step, the comment is provided “to a medical information specialist in the intermediary” and the medical information specialist “report[s] the continuing medical education credit based at least on the comment in a database accessible from the intermediary”. Clearly, a reference which discloses nothing about providing continuing education credit or about consultations via an intermediary *cannot* disclose anything about a “method of providing continuing medical education credit” whose method steps are “performed in the intermediary”. Since that is the case, Telemedicine does not anticipate the claim and the rejection of the claim under 35 U.S.C. 102 is without basis.

*Rebuttal of Examiner's arguments in the Office action of 10/18/2005*

Beginning at the bottom of page 6 of her Office action, Examiner attempts to deal with the above problems by noting first that the reference refers to a number of networks that offer CME credits; however the reference discloses *nothing* about methods for giving the credits, which is what claim 1 addresses. Examiner then finds the “intermediary” disclosed in MedVision, which markets “software that enables family physicians and specialists to exchange stored video images and medical records”, but it would not appear that MedVision is acting as an “intermediary” in the sense required by the claim. Examiner further cites the MEDNET health care communications network as being the intermediary. It is clear from the disclosure that MHDI permits exchanges of all kinds of information, but again there is no disclosure of the information exchanges set forth in Applicants’ claim, namely the exchanges between the first and second physicians via the intermediary during the consultation, the exchange between the second physician and the intermediary with regard to the comment, the provision of the comment to the medical information specialist, or the recordation of the MCEC by the medical information specialist.

Examiner’s discomfort with the logic of her arguments becomes apparent when she states at the end of the arguments,

Furthermore, the courts have stated that if a prior art device in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed that the device will inherently perform the claimed process. (page 8, first paragraph)

The problem with this argument is that as set forth above, the reference provides a general disclosure of ways in which telecommunications systems have been used to communicate medical information, but very little disclosure of particular ways of performing such communications and no disclosure at all of many of the limitations of Applicants' particular method. If Telemedicine is taken to disclose a device that inherently perform the steps of Applicants' particular method, the reference must also be taken to disclose a device that inherently performs the steps of all other methods of using telecommunications systems to communicate medical information. As any Examiner who is employed in Group 3600, E-commerce, must understand, such a position is untenable.

*Patentability of the dependent claims in their own rights*

Continuing with claim 2, Telemedicine discloses nothing about the use of an intermediary with a medical information specialist in a consultation between doctors, and can thus disclose nothing about the additional steps performed in the intermediary in the claim. Claim 2 is thus patentable in its own right over Telemedicine.

With regard to claims 3 and 4, Examiner finds the added limitations in Abrahamson. Applicants respectfully submit that Abrahamson teaches nothing beyond the use of a computer system to give and grade examinations. The added limitations of claims 3 and 4, however, are added to the contexts provided by claims 2 and 1 respectively, and because Telemedicine does not disclose all of the limitations of those contexts and Abrahamson discloses nothing further regarding the limitations that Telemedicine does not disclose, the combination of the reference does not disclose all of the limitations of claims 3 and 4. Since that is the case, Examiner has not made the *prima facie* case of obviousness required by MPEP 2143. These claims are consequently patentable in their own rights over Telemedicine and Abrahamson.

**Conclusion**

Applicants have amended their Abstract to overcome the objection to the Specification, have amended claim 1 to overcome the rejection under 35 U.S.C. 112, 2. paragraph, have overcome the rejection of claim 1 under 35 U.S.C. 101 by a combination of amendment and argument, and have traversed the rejection of claims 1 and 2 as anticipated by Telemedicine and of claims 304 as obvious over Telemedicine and Abrahamson. Applicants have thereby been completely responsive to Examiner's Office action of 10/18/2005 and have thus satisfied the requirements of 37 C.F.R. 1.111(b). Applicants consequently request that Examiner reconsider her rejections as provided by 37 C.F.R. 1.111(a) and allow the claims as amended. A petition for a 1-month extension of time and a check for the requisite fee of \$60.00 are included with this response. No other fees are believed to be required by way of this amendment. Should any be, please charge them to deposit account 501315.

Respectfully submitted,



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